

Remarks

Applicant hereby adds new claims 30-44. Accordingly, claims 1-44 are pending in the present application.

Claim 1 stands rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 4,750,838 to DeWolf et al. Claim 9 stands rejected under 35 USC 102(b) for anticipation by DeWolf. Claims 13-15 and 22-24 stand rejected under 35 USC 102(b) for anticipation by DeWolf. Claims 25-29 stand rejected under 35 USC 102(b) for anticipation by U.S. Patent No. 6,384,918 to Hubble, III et al. Claims 2-5 stand rejected under 35 USC 103(a) for obviousness over DeWolf in view of Hubble, III. Claims 6-8, 12 and 16 stand rejected under 35 USC 103(a) for obviousness over DeWolf in view of U.S. Patent No. 6,952,263 to Weiss et al.

Applicant respectfully traverses the rejections and requests allowance of all pending claims.

Referring to the anticipation rejections, Applicant notes the requirements of MPEP §2131 (8th ed., rev. 3), which states that TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM. The **identical invention** must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Referring to claim 1, the method recites using electrical circuitry, determining a color on an area, and using electrical circuitry, selecting, based on the color, one of a plurality of different illumination sources appropriate to determine optical density of the color. The teachings of DeWolf relied upon by the Office in the anticipation rejection fails to disclose or suggest details of the selection of the light-emitting diode of DeWolf. In particular, DeWolf fail to teach or suggest the claimed determining a color on an area using circuitry or the claimed *selecting, based on the color, one of a plurality of different illumination sources appropriate to determine optical density of the color using electrical circuitry*. DeWolf is void of disclosing or suggesting the claimed determining using electrical circuitry or selecting using electrical circuitry and positively recited limitations of claim 1 are not disclosed nor suggested by the prior art and claim 1 recites allowable subject matter for at least this reason.

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The claims which depend from claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to claims 6-8, the Office rejects the method over Weiss and DeWolf. However, there is no motivation to combine the reference teachings and the Office has failed to establish a proper *prima facie* 103 rejection for at least this reason. More specifically, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2). As discussed below, the alleged motivation is not supported by objective evidence of record and the 103 rejection is improper for at least this reason.

MPEP 2142 (8th ed., rev. 3) states that the concept of *prima facie* obviousness allocates who has the burden of going forward with production of evidence in each step of the examination process and the *examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.* The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, that is, the initial burden is on the examiner to **provide some suggestion of the desirability of doing what the inventor has done.** MPEP §2142 (8th Ed., rev. 3).

Applicants respectfully submit the motivational rationale is insufficient in view of precedent set forth by the Federal Circuit, and accordingly, the Office has failed to meet their burden of establishing a proper *prima facie* 103 rejection. The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee*

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Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and *can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense but rather specific factual findings are needed. The Court further stated that the determination of patentability must be based on evidence. MPEP 2143.01 (8th ed., rev. 2) cites *In re Lee* and states the importance of relying upon objective evidence and making specific factual findings with respect to the motivation to combine references.*

The Office baldly alleges that the combination of Weiss and DeWolf is appropriate to allow for compensation of the signal rather than adjustment of the apparatus. However, the Office has provided no evidence that the modification proposed by the Office provides any benefit over the already disclosed arrangement of DeWolf to motivate one to look for other teachings. There is no evidence that allowing "for compensation of the signal" provides any benefit or improvement over the disclosed operations of DeWolf. There is no evidence of record that DeWolf requires "adjustment of the apparatus," and assuming arguendo, DeWolf does require adjustment of the apparatus, there is no evidence of record that the modifications proposed by the Office provide improvements over the teachings of DeWolf. In sum, contrary to the authority of the MPEP and Federal Circuit, the Office has failed to recite objective evidence of record to support the bald, cursory and generic allegations of motivation to combine the reference teachings. Furthermore, DeWolf already addresses and solves the heat issue at col. 3, lines 20+ and there is no evidence of record that the added complexity of Weiss provides any improvements over DeWolf's solution to motivate one to look to Weiss for meaningful teachings. The Office has failed to establish a proper prima facie 103 rejection in view of the lack of proper motivation and the 103 rejection is improper for at least this reason.

Referring now specifically to claim 8, positively recited limitations of the claim are not disclosed nor suggested by the prior art even if the prior art references are combined and the Office has failed to establish a proper prima facie rejection for at least this additional reason. More specifically, claim 8 clearly recites the

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compensating for the effects of heating further comprises *generating a corrected signal indicative of optical density using a non-linear relationship between the voltage across the LED and the signal*. On pages 9-10 of the Office Action, the Office relies upon the teachings of cols. 14-15 of Weiss in support of the rejection. However, at col. 14, lines 63+ of Weiss it is stated that the varying of the temperature effect on the output of an LED *and the detection signal is linear*. Applicants have electronically searched Weiss and have failed to uncover any nonlinear or non-linear teachings. Accordingly, even if the references are combined, the combination fails to disclose or suggest the limitations of claim 8 and claim 8 is allowable for at least this reason.

Referring to claim 9, the method recites printing an area having a color, and *based on the color, automatically selecting one of a plurality of illumination sources without user input*. The teachings of DeWolf relied upon by the Office in the anticipation rejection fail to disclose or suggest details of the selection of an illumination source. In particular, DeWolf fails to teach or suggest the claimed automatically selecting one of the plural sources without user input. Positively recited limitations of claim 9 are not disclosed nor suggested by the prior art and claim 9 recites allowable subject matter for at least this reason.

The claims which depend from claim 9 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 13, the claimed densitometer comprises a processor coupled to the sensor for converting the received radiation to a standardized signal indicative of standardized optical density. In support of the anticipation rejection, the Office states on page 3 of the Action that the teachings of cols. 1, 2, and 6 of DeWolf allegedly disclosed the above-recited limitations. However, Applicants have failed to uncover in such teachings *any standardization teachings let alone the processor for converting the received radiation to a standardized signal indicative of standardized optical density*. Furthermore, Applicants have electronically searched DeWolf and have failed to identify any standardized optical density teachings in DeWolf. Positively recited limitations of claim 13 have been improperly ignored in formulating the anticipation rejection and claim 13 is allowable for at least this reason.

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The claims which depend from claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 17, Applicants respectfully submit the Office has failed to identify proper motivation consistent with the authority of the Federal Circuit and MPEP and the Office has failed to meet their burden of establishing a prima facie rejection and claim 17 is allowable for at least this reason.

More specifically, the Office baldly alleges on page 9 of the Action that the combination of Hubble with DeWolf is proper "for further processing and calibration of the data, as well as allow for better compatibility between the light source and the test patch, and allow for better access to the look-up table containing precalibrated information for better matching of the data and the selection of the illumination sources." The Office has failed to identify any objective evidence to support the conclusory above-recited alleged motivation in support of the rejection of claim 17 and the rejection is improper for at least this reason. The Office has failed to identify any objective teaching to support the bald allegation of the "further processing and calibration of the data" provided by the combination of reference teachings. No shortcomings have been identified with respect to the teachings of DeWolf to motivate one to look to Hubble and the rejection is improper for at least this reason. The Office has failed to identify any objective teaching that DeWolf suffers from problems of compatibility between the light source and the test patch or that any improvement would be provided with respect thereto if the teachings are combined. The Office has failed to identify any objective teaching that DeWolf suffers from problems of accessing a look-up table or that any improvement would be provided with respect thereto if the teachings are combined. In sum, the Office has failed to identify any evidence of record to support the bald allegations regarding improvements if the references are combined compared with the reference teachings taken individually. The Office has not supported the alleged motivation with objective evidence and the Office has failed to meet their burden of establishing proper motivation to combine the reference teachings. The Office has failed to establish a proper prima facie rejection and claim 17 is allowable for at least this reason.

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Furthermore, even if the references are combined, the combination fails to disclose or suggest limitations of claim 17. In particular, Applicants have failed to uncover any teachings in DeWolf regarding the processor selecting one of a plurality of different illumination sources to determine the standardized optical density of the area and the selection being responsive to the determination of the color by the processor. Furthermore, the teachings of Hubble relied upon by the Office fail to cure the deficiencies of the teachings of DeWolf. More specifically, the teachings in col. 8, lines 42+ refer to color correction not optical density. Furthermore, the teachings baldly state that colors on a test patch may be sensed and a plurality of illumination sources is used for sequentially illuminating a test patch with different illumination colors. Mere sensing of colors and the sequential illumination without disclosure of such being associated with the sensing fails to disclose or suggest the claimed processor selecting one of a plurality of different illumination sources to determine the standardized optical density of the area and the selection being responsive to the determination of the color by the processor. Accordingly, limitations of claim 17 are not disclosed nor suggested by the prior art even if the references are combined and the Office has failed to establish a prima facie rejection of claim 17 for at least this reason.

Referring to claim 24, DeWolf fails to teach or suggest the determining a color on an area using circuitry or the claimed selecting, based on the color, one of a plurality of different illumination sources appropriate to determine optical density of the color using circuitry. Claim 24 is allowable for at least this reason.

Referring to claim 25, the Office on page 4 of the Action relies upon the teachings of the Abstract and cols. 1 and 4 of Hubble in support of the rejection. However, Applicants have failed to locate any reference in the identified teachings of Hubble to the densitometer positioned to illuminate the area and generate a standardized signal indicative of standardized optical density of the area responsive to the illumination. Further, Applicants have electronically searched and failed to uncover any teachings in Hubble of the densitometer generating the standardized signal indicative of standardized optical density as recited in claim 25. Positively-recited limitations of claim 25 are not disclosed nor suggested by Hubble and the rejection is improper for at least this reason.

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The claims which depend from claim 25 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicants have identified herein numerous claimed limitations which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a *non-final Action* if any claims are not found to be allowable. In particular, Applicants request identification of specific reference teachings which allegedly disclose at least standardized and non-linear limitations recited in the claims so Applicants may appropriately respond during the prosecution of the present application.

Applicants hereby add new claims 30-44. The amendments to the claims and the new claims are supported at least by Figs. 1-3 and the associated teachings of the originally filed specification.

Applicants submit a supplemental IDS herewith.

Applicants also submit a copy of a previously filed 1449 which does not include initials for the submitted references. Applicants respectfully request initialization of each of the references on the form and return of the form to Applicants.

Applicant respectfully requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is

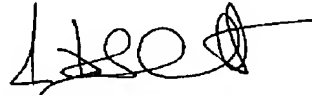
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available for telephone consultation at any time during normal business hours
(Pacific Time Zone).

Respectfully submitted,
Omer Gila et al.

By



James D. Shaurette

Reg. No. 39,833

Date: 1/27/06

(509) 624-4276

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